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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,288	03/21/2001	Noriko Ito	14419	4794

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EXAMINER

LAstra, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,288

Applicant(s)

ITO, NORIKO

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/21/01:05/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-17 have been examined. Application 09/814,288 (ADVERTISEMENT PROVIDING SYSTEM AND METHOD) has a filing date 03/21/2001 and foreign priority of 03/30/00.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 recites the limitation "the communication dealer" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites "producing the advertisement data". For purpose of art rejection, the feature is interpreted as "the consumer responding to the received advertisement data".

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9 and 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9 and 14-16 are not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore,

the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claim 9 recites a "useful, concrete and tangible result" (an advertisement providing method), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts). Dependent claims 14-16 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al (U.S. 6,571,279).

As per claim 1, Herz teaches:

An advertisement providing system comprising a communication line, one or more communication dealer terminals, one or more consumer terminals and one or more company terminals, these terminals being interconnected by the communication line, wherein:

each communication dealer terminal includes a means for storing advertisement data and also consumer's position data and taste data, and a means for selecting

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advertisement data for each consumer by taking the consumer's position data and taste data and also time into considerations (see column 25, line 10 – column 26, line 62);

each consumer terminal includes a means for displaying advertisement data received from each communication dealer terminal, a means for transmitting the consumer terminal's position data to the communication dealer terminal, and a means for transmitting reservation request data for a product or a service selected by the consumer on the basis of the advertisement data (see column 26, lines 49-62); and

each company terminal includes a means for producing advertisement data and transmitting the produced advertisement data to the communication dealer terminal (see column 16, lines 7-34),

a means for receiving the reservation request data via the communication dealer terminal and executing a reservation process, a means for making a check, when the consumer comes to the shop, as to whether the consumer has requested a reservation, and a means for allowing the company to sell a goods or a service to the consumer (see column 26, lines 29-62).

As per claim 2, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the advertisement data as electronic mail to the consumer terminal (see column 8, lines 51-65).

As per claim 3, Herz teaches:

The advertisement providing system according to claim 1, wherein the consumer terminal transmits the reservation request data as electronic mail to the communication dealer terminal (see column 25, lines 25-67).

As per claim 4, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the reservation request data as electronic mail to the company terminal (see column 26, lines 29-62).

As per claim 5, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication line is an Internet system (see column 25, lines 55-67).

As per claim 6, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal further includes a means for calculating a scheduled time of consumer's arrival at shop from the present position of the consumer, the position of the shop as described in the advertisement and the present time and transmitting the scheduled time data to the company (see column 25, lines 25-40; column 26, lines 49-62).

As per claim 7, Herz teaches:

The advertisement providing system according to claim 1, wherein the communication dealer terminal further includes a means for calculating advertisement effect from the contract of advertisement requested to it and transmitted reservation request data of consumers (see column 25, lines 1-25).

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As per claim 8, Herz teaches:

The advertisement providing system according to claim 7, wherein the communication dealer terminal further includes a means for determining advertisement fee from the advertisement effect (see column 5, lines 15-35).

As per claim 9, Herz teaches:

An advertisement providing method comprising:

a step for selecting advertisement data from the position data and taste data of a consumer and the time;

a step for transmitting the advertisement data to the consumer;

a step for showing the advertisement data to the consumer terminal;

a step for transmitting the position data to the communication dealer;

a step for transmitting a reservation request of a goods or a service to the communication dealer when the consumer thinks the goods or service to be his or her favorite item as a result of comprehending the advertisement data;

a step for producing the advertisement data and transmitting the produced advertisement data to the communication dealer terminal;

a step for accepting the reservation request of consumer from communication dealer;

a step for executing a reservation process;

a step for making a check as to whether the consumer has requested a reservation when the consumer appears at shop; and

a step for selling a product or a service to the consumer. The same rejection applied to claim 1 is applied to claim 9.

As per claim 10, Herz teaches:

The advertisement providing method according to claim 9, wherein the advertisement is transmitted as electronic mail to the consumer. The same rejection applied to claim 2 is applied to claim 10.

As per claim 11, Herz teaches:

The advertisement providing method according to claim 9, wherein the consumer transmits the reservation contrast data as electronic mail to the communication dealer. The same rejection applied to claim 3 is applied to claim 11.

As per claim 12, Herz teaches:

The advertisement providing method according to claim 9, wherein the communication dealer transmits the reservation request data as electronic mail to the company. The same rejection applied to claim 4 is applied to claim 12.

As per claim 13, Herz teaches:

The advertisement providing method according to claim 9, wherein the consumer terminal, the communication dealer terminal and the company terminal are interconnected via an Internet system. The same rejection applied to claim 5 is applied to claim 13.

As per claim 14, Herz teaches:

The advertisement providing method according to claim 9, wherein the communication dealer calculates the scheduled time of consumer's arrival at shop from

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the present position of the consumer, the position of the shop as described in the advertisement and the present time and transmits the scheduled time data to the company. The same rejection applied to claim 6 is applied to claim 14.

As per claim 15, Herz teaches:

The advertisement providing method according to claim 9, wherein the communication dealer calculates advertisement effect factor from the contract of advertisement requested to the communication dealer and transmitted reservation request data of consumers. The same rejection applied to claim 7 is applied to claim 15.

As per claim 16, Herz teaches:

The advertisement providing method according to claim 15, wherein the communication dealer further comprises a step of determining advertisement fee from the advertisement effect factor. The same rejection applied to claim 8 is applied to claim 16.

As per claim 17, Herz teaches:

A communication dealer terminal for an advertisement providing system connected to consumer terminals and company terminals via an Internet system comprising:

a means for storing advertisement data from the consumers and also position data and taste data from the consumers; and

a means for selecting advertisement data for each consumer from the considerations of the position data and taste data of the consumer and the time and transmitting

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the advertisement data to that consumer. The same rejection applied to claim 1 is applied to claim 17.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Chen teaches a system for reducing excess capacity for restaurants during off peak or other times.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

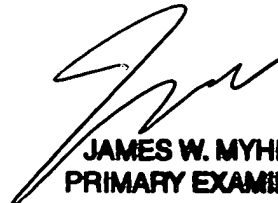
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra

September 2, 2004



JAMES W. MYHRE
PRIMARY EXAMINER